

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant : Biro et al. | Art Unit : 2833 |
| Patent No. : 7,479,045 | Examiner : Edwin A. Leon |
| Issue Date : January 20, 2009 | Conf. No. : 3075 |
| Serial No. : 10/676,813 | |
| Filed : September 30, 2003 | |
| Title : POWER DISTRIBUTION ADAPTABLE TO DIFFERENT POWER SUPPLIES | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 810 to 1219 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. See 35 U.S.C. § 154(b)(2)(A). As outlined in *Wyeth v. Dudas*, F. Supp. 2d 138, 188 (D.D.C. 2008) (CA No. 07-1492, Mem. Op.), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. See *id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The *Wyeth* court

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determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. *See id.*

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before November 30, 2004 (the date that is fourteen months after September 30, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on July 24, 2007, thereby according a PTO Delay of 966 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from December 1, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to July 24, 2007. *See* 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 966 days.

“B Delay”

The period beginning on December 1, 2006 (the day after the date that is three years after the date on which the application was filed), and ending January 20, 2009 (the date the patent was issued), is 843 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on September 5, 2008, and the patent issued on January 20, 2009, which resulted in a period of 137 days that must also be excluded from the three year delay calculation. *See* 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. *See* 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

"B Delay" for this patent is therefore calculated as 843 days minus 137 days, for a total of 706 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 706 days.

Overlap of "A Delay" and "B Delay"

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 297 days, from December 1, 2006, to July 24, 2007.

Applicant Delay

A reply to an Office Action was due on or before October 24, 2007 (the date that is three months after July 24, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on February 26, 2008, thereby according an Applicant Delay of 125 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from October 25, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to February 26, 2008. *See* 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before August 5, 2008 (the date that is three months after May 5, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 5, 2008, thereby according an Applicant Delay of 31 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from August 6, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to September 5, 2008. *See* 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 156 days (i.e., the sum of 125 days and 31 days).

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CONCLUSION

In consideration of the events described above, Patentee believes the PTA calculation of 810 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,375 days (i.e., the sum of 966 days of "A Delay" and 706 days of "B Delay" minus the 297 days of overlap);
- 2) Total Applicant Delay should be calculated as 156 days; and
- 3) Total PTA should be calculated as 1219 days.

This patent is not subject to a terminal disclaimer.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-1312001.

Respectfully submitted,

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